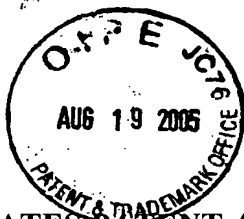


DOCKET NO.: 212766US6/ycs



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

GROUP: 2151

Koichi MATSUDA, et al.

SERIAL NO: 09/929,052

EXAMINER: John B. Walsh

FILED: August 15, 2001

FOR: RECEIVING APPARATUS AND METHOD, SENDING APPARATUS AND
METHOD, RECORDING MEDIUM, AND COMMUNICATION SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney or agent of record or acting under 37 C.F.R. § 1.34.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Bradley D. Lytle
Registration No. 40,073

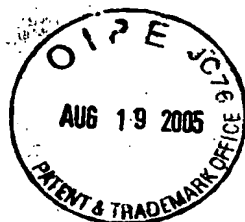
Customer Number

22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 07/05)

Scott A. McKeown
Registration No. 42,866

DOCKET NO: 212766US6



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
KOICHI MATSUDA, ET AL. : EXAMINER: JOHN B. WALSH
SERIAL NO: 09/929,052 :
FILED: AUGUST 15, 2001 : GROUP ART UNIT: 2151
FOR: RECEIVING APPARATUS AND :
METHOD, SENDING APPARATUS AND
METHOD, RECORDING MEDIUM, AND
COMMUNICATION SYSTEM

REMARKS ACCOMPANYING
PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants respectfully request that a Pre-Appeal Brief Conference be initiated in accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005.

FAILURE TO PRESENT A PRIMA FACIE CASE OF ANTICIPATION

Applicants submit that the Official Action of May 19, 2005, and the Advisory Action of July 18, 2005 have failed to provide a *prima facie* case of anticipation with respect to Claims 1, 3-6, and 8-10 under 35 U.S.C. § 102.¹

Pending Claims 1, 3-6, and 8-10 stand rejected under 35 U.S.C. § 102 in view of Forsen.

¹ See Official Action of May 19, 2005 detailing the rejections of Claims 1, 3-6, and 8-10 under 35 U.S.C. § 102 based on U.S. Patent No. 6,073,166 (hereinafter Forsen)

Applicants Claim 1 recites, *inter alia*, a receiving apparatus for receiving mail of a sending apparatus, including:

... said data is status information of a specific point of processing, which has been executed by said sending apparatus.

As discussed in detail in the Response of June 24, 2005, nowhere in the Official Action of May 19, 2005, or in the Advisory Action of July 18, 2005, is there a discussion of the cited reference relative to the above claim language. In response to this assertion, the Advisory Action provided the following explanation:

The applicant argues that Forsen does not disclose said data is status information of a specific point of processing. The applicant further argues that in operation, incremental changes made by way of email communication from a sender to a receiver can be automatically executed at each terminal depending upon the point of processing to facilitate interactive communication. The applicant has not claimed that the data for specific point of processing is incrementally changed. Furthermore, Forsen discloses, executing, processing corresponding to data which is associated with a specific point of processing (column 3, lines 32-38, 45-57), such that in operation incremental changes made by way of email communication from a sender to receiver can be automatically executed.

As can be seen from the plain text of this cited portion of Forsen, the assertion made in the Advisory Action is clearly misguided.² Simply stated, the cited portion of Forsen describes that a mail object may include executable components, such as JAVA routines. There is no disclosure, or suggestion, of providing data, which is status information of a specific point of processing, which has been executed by said sending apparatus. The JAVA routines of Forsen are described as “buttons and clickable elements.” Clearly, such objects are not first executed by a sending apparatus, such that a specific point of processing provided to a receiving apparatus. Likewise, the rationale of the Official Action of May 19,

² The discussion of incremental changes in Applicants’ previous response refers to the benefits of employing a specific point of processing.


2005 discussing Forsen is deficient in the same manner.³ Yet, it is well settled that all claim limitations must be taught or suggested (*See In re Royka*, 180 U.S.P.Q.580 (C.C.P.A. 1974)).

CONCLUSION

Based on this clear legal deficiency in the above-noted rejection, Applicants respectfully request that prosecution be re-opened as the current grounds of rejection have not been clearly development to such an extent that the Applicants can readily judge the Examiner's position or the advisability of preparing a traditional Appeal Brief.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Bradley D. Lytle
Attorney of Record
Registration No. 40,073

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

Scott A. McKeown
Registration No. 42,866

BDL:SAM:ycs

I:\ATTY\SAMPROSECUTION WORK\212766\PRE-APPEAL BRIEF REVIEW.REMARKS.DOC

³ See Official Action at page 2, para. 2.